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IN THE
Supreme Court of the United States

OCTOBER TERM, A. D. 1942.

HARVEY S. COVER,

Petitioner,

v.

NATHAN SCHWARTZ, doing business as HYGEIA RESPIRATOR CO.,

Respondent.

**PETITION FOR WRIT OF CERTIORARI TO THE
CIRCUIT COURT OF APPEALS FOR THE
SECOND CIRCUIT, AND BRIEF IN
SUPPORT THEREOF.**

JOSHUA R. H. POTTS,
EUGENE VINCENT CLARKE,
Counsel for Petitioner.

160 North La Salle Street
Chicago, Illinois

U. S. Law Printing Co., Phone Lakeview 6581, Chicago, Illinois



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PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

*To the Honorable Chief Justice of the United States and
Associated Justices of the Supreme Court of the United
States:*

Your petitioner, Harvey S. Cover, prays for a writ of certiorari to the Circuit Court of Appeals for the Second Circuit, to review that portion of the judgment of that Court entered January 11, 1943, holding Claims 1-8 and 10 of Patent No. 2,065,304 to Harvey S. Cover invalid (Opinion R. 391).

A transcript of the record in the case, including the proceedings in said Circuit Court of Appeals, is furnished herewith, in accordance with the rules of said Court.

STATEMENT.

1. Your petitioner seeks a reversal of that portion of the judgment of the Circuit Court of Appeals for the Second Circuit, affirming the judgment of the District Court for the Southern District of New York, which held Claims 1-8 and 10 of patent No. 2,065,304, dated Jan. 9, 1936 (R. 162), issued to Harvey S. Cover, relating to Respirators, invalid for want of invention. Infringement was conceded.

2. This suit was filed on June 7, 1937, being the usual suit for infringement of claims 1 to 8 and 10 of the patent, injunction, accounting, etc. There was a counterclaim filed, but this was dismissed and is not important here. This suit, was tried together with another suit filed by the plaintiff on two other patents. The other suit is not in any way involved in this proceeding.

After suit was filed, an interference was declared on the 16 day of July, 1937, relating to the subject-matter of the patent between the same parties to the suit. The trial of the case was enjoined until the completion of the interference. The interference proceeded through the Examiner of Interferences, the Board of Appeals and the United States Court of Customs and Patent Appeals, which decided in favor of the plaintiff Cover.

When the case came on for trial, in November 1941, the defendant waived the defense on non-invention and claimed that the defendant, Schwartz, was the first inventor of the subject-matter of the patent. Infringement was conceded

(R. 27-28). Although the question of want of invention was waived, the District Court held that the patent was invalid for want of invention over patent 2,019,928 (R. 274) to Punton, filed December 18, 1934, and issued November 5, 1935.

Both parties agreed that the subject-matter involved invention. Not one witness testified to the contrary. The defendant Schwartz, who had 33 years experience in respirators, not only stated by his counsel that the only issue would be priority, but testified that the subject-matter of the patent involved invention. He testified on cross examination:

"For argument, I concede, your Honor, that there is invention in placing this filter pad behind this particular flange, and I showed it on June 22nd in the Patent Office before Cover, and therefore I contend it is my invention. (R. 43.)

"I will again concede, in my opinion, that there is involved invention in placing extrusions in the plate of the filter holder." (R. 43.)

All the witnesses who testified on invention testified that the subject-matter involved invention. The only witnesses produced by the defendant were for the purpose of proving that Schwartz was the prior inventor.

The District Court failed to find in favor of Schwartz on this claim that Schwartz was the prior inventor. The Court, although not making a formal finding of the matter, held that Cover was the prior inventor (R. 155).

In view of the fact that the defense of non-invention was waived, the plaintiff produced in evidence the proceedings in the Court of Customs and Patent Appeals, awarding priority to Cover, and rested, without calling to the stand the inventor.

Despite the fact that the only issue was priority, and despite defendant's testimony that invention was involved in the patent, the Court held the patent invalid for want of invention, on the authority of *Cuno v. Automatic Service Corp.*, 314 U. S. 84, 91.

The defendant's only contention was that Schwartz was the prior inventor, and his counsel stated:

"Mr. Halle, what we are trying to demonstrate is that Cover was not the first inventor" (R. 37).

The patent in question relates to improvements in respiratory masks for miners, and other workers, the purpose of which is to protect the wearer against dust and poisonous gases and the occupational diseases which might otherwise result.

The proof showed that the most important features in a respirator are comfort and minimum breathing resistance. The breathing resistance, especially in a heavy respirator, reduces the wearer's physical efficiency and may cause him to work without a respirator, with consequent ill consequences to his health. Workmen do not like to wear respirators, and disregard them frequently when they are not under observation. The record showed further that it is essential that the respirators be made with a maximum of comfort, lightness in weight, efficiency and convenience.

The Punton device, in order to overcome breathing resistance, is primarily concerned with the use of a piece of filter paper 7, adapted to be vibrated to check off dust, etc. deposited by the elements.

Among other elements there were five elements including a purported cover which were essential to the Punton device, which we will not detail at this time.

This Punton device represented the best conception of a practical respirator known to Punton or to the Mine Safety

Appliance Co., which is the assignee of the Punton patent. The Mine Safety Appliance Co. is the largest manufacturer of respirators in this country. All these parts were essential to the Punton device, which was presumably the latest and the best that the skill of the art could supply.

Cover, however, by a brilliant conception produced a new and startlingly improved device so that a lesser number of parts performed all the functions of the greater number, and made an invention of a high order. He eliminated all the five aforesaid parts from the Punton device, which those skilled in the art considered essential, and showed that the perforated cover was as unnecessary as a perforated cover would be over eye-glasses to "help vision". He also showed that the extra parts involved disadvantages because they added weight and provided additional discomfort and blocked off 75 per cent of the breathing area of the filter, besides causing the respirators to be more expensive to make.

The United States Supreme Court has a number of times stated:

"A reconstruction of a machine so that a less number of parts will perform all the functions of the greater, may be invention of a high order * * * It is invention to omit from a prior process a step which those skilled in its performance consider essential but which the inventor proved to be useless."

Walker on Patents, 6 Ed., Sec. 73;

McClain v. Ortmyer, 141 U. S. 425;

Lawther v. Hamilton, 124 U. S. 1;

Consolidated Store Service Co. v. Seigel-Cooper Co., 107 F. R. 716;

Dececo Co. v. Gilchrist Co., 125 F. R. 293.

The record shows that everybody but the trial Judge considered the Cover improvement an invention, to-wit: the Examiner of Interferences, the three members of the

Board of Appeals and five Judges of the Court of Customs and Patent Appeals, in addition to the parties themselves and the expert witnesses. The defendant not only conceded the improvement but thought so highly of the invention he rushed a patent application into the Patent Office, claiming to be the prior inventor, and tried to get a patent on the same invention, and contested a long, bitter and expensive fight to the Court of Customs and Patent Appeals to try to obtain a patent on the invention.

The evidence showed that the experienced defendant, Schwartz had just introduced two new respirators on the market which he advertised as "new," "the easiest" and the "lightest" on the market. Despite this, as soon as Schwartz saw the Cover device on the market, he immediately and deliberately imitated that device. The defendant Schwartz immediately sought to have tests made of his device by the Standard Saftey Equipment Co. of Chicago, to see if he could obtain the approval of the United States Bureau of Mines, which he had never been able to obtain. The Standard Company (which was Schwartz' jobber) called attention to the obvious infringement on the Cover patent and urged that Schwartz give very serious consideration to the patent situation before investing any further money in the development of the respirator. Schwartz then notified the Standard Company that he was discontinuing the respirator. The Standard Company, which sells a larger variety of respirators than any other Company in the United States, wrote Schwartz as follows:

"It happens that at the present time we are selling a very considerable quantity of the new Dupor (the Cover device) simply because it is a good respirator. If you can produce something that is better, we can assure you we will be glad of the opportunity to sell it. * * * We felt you would not want to stick your neck

out for trouble and that a little warning in advance, based on our acquaintance with other respirators, might save you some money and a lot of grief, for patent suits are expensive whether you win or lose them. (I. R. 345.) In the face of all this warning and notice, Schwartz nevertheless went ahead copying the invention and obtained a Bureau of Mines Approval for the first time in his life. (I. R. 287, *et seq.* 730.)

The record shows that Schwartz had filed about 25 patent applications on respirators without being able to make the invention (R. 95).

The record shows that the prior art Punton patent which was held to invalidate the Cover patent, was considered in the Patent Office, and that the presumption of validity resulting from the allowance of the Cover patent was strengthened by the bitter interference contest waged against it by Schwartz to the Court of last resort, to-wit: the Court of Customs and Patent Appeals. The record also shows that 27,287 devices like that of the Cover patent were sold between October, 1936 and December, 1938, the date when the testimony regarding commercial success was taken.

The Court admitted that it was "not skilled in the art." (R. 38).

The Second Circuit Court of Appeals admits that very few men on the bench can qualify as scientific experts.

Parke-Davis v. H. K. Mulford Co., 189 F. 95, 115;

Picard v. United Aircraft Corporation, decided May 28, 1942, 128 F. (2d) 632.

more than the ordinary skill of the art * * * (basing its holding on the authority of *Cuno Engineering Corporation v. Automatic Service Corporation*, 314 U. S. 84, 91).

“How long we shall continue to blunder along without the aid of unpartisan and authoritative scientific assistants in the administration of justice, no one knows. * * *” (*Parke-Davis v. Mulford*.)

Judge Frank, in his concurring opinion in the *Picard* case refers to the “haphazard” scientific information of justice.

Despite all this, and despite the testimony of the defendant himself (an expert with 33 years experience) to the inventive advantages of the Cover device, and despite the defendant’s concession of inventiveness, the lower Court (which confessed itself unskilled in the art) held the patent invalid.

The *Cuno* decision had been handed down just before the trial, and the court at the beginning of the trial called the attention of the attorneys to that decision, and stated that the Judges of the District Court for the Southern District of New York had held a meeting to consider the implications of the *Cuno* case and had decided that they would hold nothing could be an invention which was not a basic invention, “such as the McCormick reaper or something like it.”

We submit that the Court narrowly interpreted the *Cuno* case to mean a literal “flash of genius” and thereby misconstrued the *Cuno* decision.

The Circuit Court of Appeals, also confessedly unskilled in the art, held the patent invalid despite the fact that the testimony was all to the contrary; that there was no testimony that the Cover device lacked invention, and that invention was not an issue. The Circuit Court of Appeals gave no reason for its holding of invalidity except to conclude that the Cover improvement involved “no

more than the ordinary skill of the art * * *” (basing its holding on the authority of *Cuno Engineering Corporation v. Automatic Service Corporation*, 314 U. S. 84, 91).

In view of the sole reliance upon the *Cuno* case in the matter of invention, and in view of the *Picard* case, 128 F. (2) 632, we submit that the Circuit Court of Appeals narrowly construed the *Cuno* case to require a literal "flash of genius" for an invention, and to mean that "Nothing is an invention which was the product of the slow but inevitable progress of an industry through trial and error," and of "the exercise of persistent and intelligent search for improvement." We submit that the Circuit Court of Appeals thereby misconstrued the *Cuno* case. *Picard v. United Aircraft* (C. C. A. 2), 128 F. (2d) 632.

Statement of Jurisdiction.

The jurisdiction of this Court is invoked under the provisions of Sec. 240 of the Judicial Code as amended by the Act of February 13, 1925 (28 U. S. C. Sec. 347). The date of the judgment to be reviewed is Jan. 11, 1943.

Questions Presented.

1. Shall the finding of a governmental agency, the Patent Office, that the Cover patent involved invention over the Punton patent be reversed, contrary to all the evidence, in the face of the fact that invention was not an issue and that all the testimony was to the effect that the Cover patent involved invention, including the testimony of the defendant who had engaged in a bitter interference and had contested it to the U. S. Court of Customs and Patent Appeals to obtain the patented invention, especially when the courts admit that they are not skilled in the art and when both parties have been experienced in the art for at least a third of a century *on the theory that the Cuno case requires a literal "flash of genius" and excludes all that is the product of the "exercise of persistent and intelligent search for improvement"?*

2. Is the Circuit Court of Appeals of the Second Cir-

cuit correct in holding that "nothing is an invention which is the product of the slow but inevitable progress * * * through trial and error and of the exercise of persistent and intelligent search for improvement," and in applying its announced interpretation of the *Cuno* case to hold claims 1-8 and 10 of Cover patent 2,065,304 invalid?

3. Did the elimination by Cover of elements considered indispensable by the prior art, which elimination produced a definitely superior and improved device, involve invention over the Punton patent and the prior art?

Reasons Relied Upon for Allowance of the Writ.

1. The Circuit Court of Appeals of the Second Circuit has literally construed the words "flash of genius" as used in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84, to mean a literal "flash of genius," and that "nothing is an invention which is the product of 'the slow but inevitable progress * * * through trial and error' and of 'the exercise of persistent and intelligent search for improvement.' "

Picard v. United Aircraft Corporation, 128 F. (2) 632.

In so doing it has:

(a) decided a federal question, in a way, probably in conflict with applicable decisions of this Court, including the *Cuno* case;

(b) interpreted the *Cuno* decision in conflict with the opinions of Courts of Appeals of other Circuits including the Sixth and Seventh.

(c) Decided a federal question in violation of Sec. 4886 of the Revised Statutes; U. S. Code, Annotated, Title 35, Sec. 31, to-wit:

"Any person who has invented or discovered

* * * a new and useful * * * machine, or any new and useful improvements thereof * * * may * * * obtain a patent therefor. * * *

(d) repealed by judicial legislation, Sec. 4886 of the Revised Statutes.

2. The Circuit Court of Appeals of the Second Circuit in applying this literal interpretation of the words "flash of genius" of the *Cuno decision*, to affirm the decision of the lower court which held claims 1 to 8 and 10 of Cover patent No. 2,065,304 invalid for want of invention over the Punton patent, although all the evidence on the subject of invention was to the effect that the Cover patent did involve invention over the Punton patent, so far sanctioned a departure from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

3. Your petitioner represents that he has no knowledge of any other infringement of patent No. 2,065,304 than by the defendant in this case, and no opportunity to bring another suit on the patent in another Circuit such as the Seventh or Sixth Judicial Circuits, to test the validity of the patent; or in any event to bring suit in said other Circuits so as to present a possible actual conflict on the same patent. Furthermore, if the holding of invalidity by the Circuit Court of Appeals is allowed to stand, a disclaimer will be necessary, which will make it impossible for plaintiff ever to present the question again, thus making it impossible to obtain a possible conflict of decisions in different circuits.

Congress, in Section 4886¹ of the "Revised Statutes"

¹ Section 4886 of "Revised Statutes" was enacted in 1870. During all that time Congress has not seen fit to change this statute. The action of the Circuit Court of Appeals of the Second Circuit amounts to judicial legislation.

did not limit the right to a patent on the method by which the invention was made, to-wit: either by a "flash of genius" or by "slow but inevitable progress" or "by persistent and intelligent search for improvement."

The Circuit Court of Appeals for the Second Circuit has, we submit, misconstrued the *Cuno* case in *Ruby Picard v. United Aircraft Corporation*, 128 F. (2) 632.

A definitive determination of this question is of the utmost importance to inventors, manufacturers, patent owners, and patent lawyers, among others. In the light of the interpretation given by the Second Circuit, and the contrasting interpretation given by the Sixth and Seventh Circuits to the words "flash of genius", the utmost confusion prevails as to what the Supreme Court means by "flash of genius" and as to what is an invention.

We realize that invention is not something tangible, or definite in itself—but, believe that it is possible for the Court to give some guide as to what it means by "flash of genius" and "invention."

In view of the disagreement in interpretation between learned, experienced Judges as to the meaning of the words "flash of genius" as used by the Supreme Court, it is manifest that the public interest would be served by a clarification of the meaning of "flash of genius". If the courts disagree, as we have indicated, on the meaning of the Supreme Court's language, manifestly it is impossible for patent owners to know what their rights are with any reasonable certainty.

We submit that the construction so given by the Circuit Court of Appeals of the Second Circuit amounts to

judicial legislation and that the foregoing manifestly constitute special and important reasons for this Court's exercising its judicial discretion to grant a review on Writ of Certiorari.

Wherefore, your petitioner respectfully prays that a Writ of Certiorari be issued out of and under the seal of this Honorable Court, directed to the United States Circuit Court of Appeals for the Second Circuit, commanding that Court to certify and to send to this Court for its review and determination, on a day certain to be therein named, a full and complete transcript of the record and all proceedings on the case numbered and entitled on its docket, No. 74, Harry S. Cover, Plaintiff-Appellant *vs.* Nathan Schwartz, Defendant-Appellee, and that the said decree of the United States Circuit Court of Appeals for the Second Circuit be reversed by this Honorable Court, and that claims 1-8 and 10 of Cover patent 2065304 be held valid, infringement being conceded, and that your petitioner may have such other and further relief in the premises as to this Court may seem meet and just.

Most respectfully submitted,

HARVEY S. COVER,

By JOSHUA R. H. POTTS,

EUGENE VINCENT CLARKE,

Counsel for Petitioner.

Chicago, Illinois,
April 7, 1943

Certificate.

This petition is, in our judgment, well founded, and is not interposed for purpose of delay.

JOSHUA R. H. POTTS,

EUGENE VINCENT CLARKE,

Counsel for Petitioner.